UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,140	10/17/2003	James E. Becvar	31695-1001	2788

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EXAMINER
FLOOD, MICHELE C

ART UNIT	PAPER NUMBER
1655	

DATE MAILED: 03/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>1</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>17 October 2003</u>.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>42-64</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) <u>42-64</u> are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Acknowledgment is made of the receipt and entry of the amendment filed on

October 17, 2003 with the cancellation of Claims 1-41 and the addition of newly

submitted Claims 42-64. The claims are drawn to more than one invention; therefore a

restriction requirement is deemed necessary, as set forth below.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I.   Claims 42-52, drawn to a method for identifying the presence of a toxic

substance in a sample using a luminescent biological agent, said method

comprising the steps of: preparing a luminescent biological agent which is

inhibited by a substance which is toxic to an organism; obtaining a

sufficient volume of the sample suspected to contain toxic substances

which are toxic to an organism to provide a test sample; separating the

toxic substances using a separation phase matrix to provide separated

toxic substances; collecting said separated toxic substances by elusion

from the separation phase matrix into a plurality of serial aliquot volumes;

and identifying the presence of said toxic substances harmful to an

organism in said aliquot volumes by luminescent inhibition, classified in

class 435, subclass 8.

II.   Claims 53-64, drawn to a method for chemically identifying a toxic

substance in a sample using a luminescent biological agent, said method

comprising the steps of: preparing a luminescent biological agent for use in conjunction with chromatography paper; obtaining a sufficient volume of the sample suspected to contain toxic substances to provide a test sample; separating the toxic substances of the test sample on a separation phase matrix to provide a first set of serial aliquot volumes; exposing said first set of serial aliquot volumes to said luminescent biological agent by spotting said serial aliquot volumes in an array or in a linear fashion on a sheet of chromatography paper and spraying said sheet with a suspension of luminescent biological agent; identifying the presence of said toxic substances in said first set of serial aliquot volumes by zones of luminescent inhibition on said chromatography paper; obtaining a second volume of the sample to form a second test sample; separating the toxic substances of the second test sample on another separation phase matrix to provide a second set of serial aliquot volumes; and determining the chemical identity of a separated toxic substance observed at areas of luminescent inhibition with said first set of serial aliquot volumes by analyzing a corresponding inhibition region with said second set of serial aliquot volumes., classified in class 435, subclass 252.3.

Inventions I-II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the two

different groups are directed to two different inventions. For instance the invention of

Group I is directed to a method for identifying the presence the presence of a toxic

substance in a sample, whereas the invention of Group II is directed to a method for

chemically identifying a toxic substance in a sample.

The two inventions above are independent and distinct, each from the other.

They have acquired a separate status in the art as a separate subject for inventive

effect and require independent searches (as indicated by the different classification).

The search for each of the above inventions is not co-extensive particularly with regard

to the literature search. Further a reference which would anticipate the invention of one

group would not necessarily anticipate or even make obvious another group. Finally,

the consideration for patentability is different in each case. Thus, it would be an undue

burden to examine all of the above inventions in one application.

Because these inventions are independent or distinct for the reasons given

above and have acquired a separate status in the art in view of their different

classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must

include (i) an election of a species or invention to be examined even though the

requirement be traversed (37 CFR 1.143) and (ii) identification of the claims

encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To

reserve a right to petition, the election must be made with traverse. If the reply does not

distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Flood whose telephone number is 571-272-0964. The examiner can normally be reached on 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Michele Flood
Primary Examiner
Art Unit 1655

MCF
March 18, 2006

MICHELE FLOOD
PRIMARY EXAMINER